

REMARKS

I. Status of Claims

Claims 80-90 are currently pending. Claims 1-79 and 91-93 were previously canceled, and claims 84 and 90 have been amended herein. Claim 84 has been amended to recite that the paper napkin formed has at least one additional transverse fold line, rather than two transverse fold lines. Support for this amendment can be found in the originally filed application, for example on page 23, paragraph [073], describing a napkin containing three panels and two transverse fold lines and on page 24, paragraph [074], describing a napkin containing four panels and three transverse fold lines. Claim 90 has been amended to correct an obvious typographical error. No new matter is added by this amendment.

II. Information Disclosure Statement

According to the Office, the Information Disclosure Statement filed January 20, 2004, fails to comply with 37 C.F.R. § 1.98(a)(2) and thus has not been considered. Applicants respectfully point out that the instant application is a divisional application, and, as stated in the January 20, 2004, Information Disclosure Statement, copies of the listed documents were previously submitted in the prior applications, Application No. 09/633,819, filing date August 7, 2000, and Application No. 09/049,103, filing date March 27, 1998, upon which Applicants rely for the benefits provided in 35 U.S.C. § 120. See 37 C.F.R. § 1.98(d), stating that a copy of references listed in an Information Disclosure Statement need not be resubmitted if the information was previously submitted in an earlier application upon which Applicants claim priority.

Applicants therefore respectfully request the Office consider the references cited in the January 20, 2004, Information Disclosure Statement and returned the initialed Form PTO SB/08 to Applicants' representatives.

III. Rejection under 35 U.S.C. § 112, First Paragraph

Claims 85 and 88-90 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. According to the Office, "[c]laim 84 (claim 85 is dependent upon claim 84) requires folding a first edge towards another then subsequently folding the first fold toward the free edge creating an additional two fold lines. It is not determinable how this process can yield three panels." Office Action at 2.

Applicants have amended claim 84 to clarify that at least one additional fold line is created. Applicants further provide herein Figure 2 of the disclosure, which illustrates one way in which the claimed method may form three panels on the single-ply paper web, as claimed in claim 85. Applicants have annotated the Figure for the Examiner's convenience.

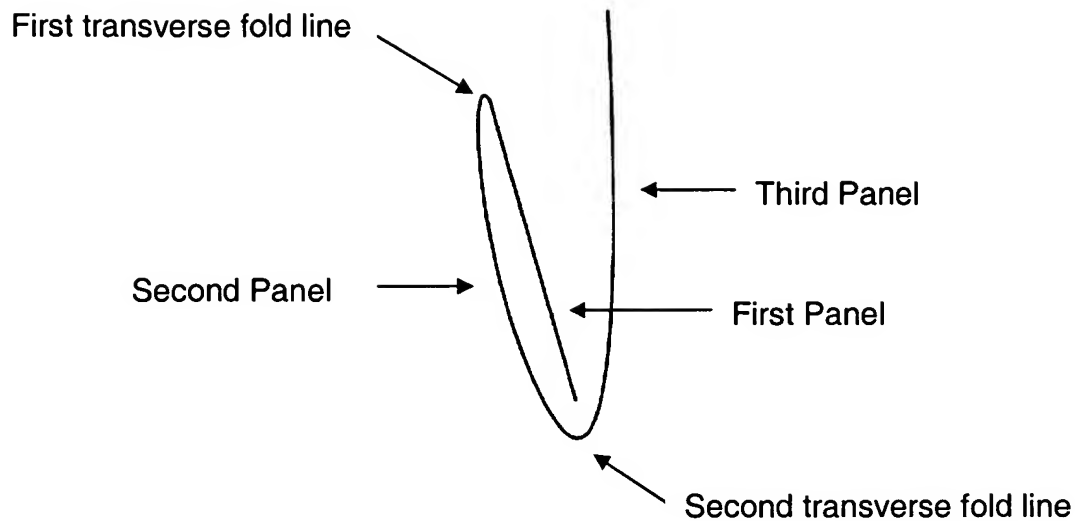


FIG. 2

As the above figure clearly illustrates, the text of claim 84 (as amended) and claim 85, as well as the disclosure at page 23, paragraph [073] and Figure 2, provide adequate written description support to enable claims 85 and 88-90. Accordingly, Applicants respectfully request that the rejection be withdrawn.

IV. Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 80-90 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. According to the Office, “the limitation ‘of at least about’ is indefinite” as “the scope of ‘about’ is not clear.” Office Action at 3. Applicants respectfully traverse.

The scope of “about,” as used in claims 80, 82, 84, and 87 is not indefinite, but rather would be clear to one skilled in the art. The Office notes that “[i]n paragraph 071, page 23 of the specification the ranges for the length are ‘about 9.5 – about 13.5 inches’

and width 'about 3 to about 7 inches,'" thus the Office concludes that "[a] specific determination of what applicant intends to cover by 'at least about 2 to 1' cannot be made." Office Action at 3.

In claims 80 and 84, the claim language provides that the cited range must be at least about 2 to 1 (i.e., the aspect ratio can be greater than about 2 to 1, but it cannot be smaller than about 2 to 1). Thus, the exemplary ranges of about 9.5 to about 13.5 inches in length and about 3 to about 7 inches in width fit within the claimed range. For example, an aspect ratio of about 9.5 to about 3 is at least about 2 to 1 because it is greater than 2 to 1. Such is also the case with the longitudinal dimensions recited in claims 82 and 87 of about 9 ½ inches to about 13 ½ inches and about 11 ½ inches to about 17 ½ inches, respectively.

Applicants additionally point out that the claim term "about" is not indefinite if one of ordinary skill in the art would be able to determine what constitutes infringement. See, i.e., M.P.E.P. § 2173.05(b), citing *Ex parte Eastwood*, 163 U.S.P.Q. 316 (Bd. App. 1968) ("[T]he term [about] is clear but flexible and is deemed to be similar in meaning to terms such as 'approximately' or 'nearly'.") and *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). See also *Amgen, Inc. v. Chugai Pharma. Co.*, 927 F.2d 1200, 1218 (Fed. Cir. 1991) (holding that term "at least about" was indefinite, but cautioning that the holding "should not be understood as ruling out any and all uses of this term [about] in patent claims. It may be acceptable in appropriate fact situations"). In the instant fact situation, the term about is clear and definite, as there is no conflicting prior art and one of ordinary skill would be able to determine the scope of the claimed

aspect ratio, given not only the ordinary meaning of the claim language, but also the specific guidance in the specification.

Claim 90 has been rejected as indefinite as the claim recites “the four panels,” which lacks antecedent basis. Claim 90 has been amended to correct the dependency of the claim. As amended, claim 90 depends from claim 86, which provides proper antecedent basis for the limitation “the four panels.” Applicants therefore respectfully request reconsideration of the rejection.

V. Rejection under 35 U.S.C. § 102(b)

Claims 80, 81, 84, and 86 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 1,256,334 to Lazar (“Lazar”). According to the Office, Lazar discloses a method of making a paper napkin according to claims 80, 81, 84, and 86. Applicants respectfully traverse.

To anticipate, a reference must teach each and every claim limitation. M.P.E.P. § 2131. Lazar, however, does not teach at least one transverse fold, as claimed herein, but rather, as one skilled in the art would readily recognize, Lazar teaches a paper towel product containing longitudinal folds. Lazar discloses that “a number of such folded sheets are then interleaved with that portion of the sheet adjacent the single fold” Lazar at page 1, ll. 104-106 (emphasis added).

This multitude of sheets involved reveals to those skilled in the art that Lazar is forming what is known in the art as a “Christmas tree,” wherein a large number of paper web sheets are folded simultaneously by plows that fold all of the sheets at once. As one skilled in the art would understand, the folding machines used in Lazar, according

to Lazar's description of using "a number of such folded sheets," inherently form longitudinal folds.

Yet the present claims are directed towards a product absent any longitudinal folds. To the contrary, the present invention does not form a Christmas tree through the use of plows, but rather uses a conventional napkin folder, thereby forming one interleaved sheet at a time.

As Lazar does not teach a napkin containing no longitudinal folds and at least one transverse fold, as claimed herein, the reference does not anticipate the claimed invention. Furthermore, nothing in Lazar would lead the skilled artisan to modify the Christmas tree arrangement or provide a product which contains transverse folds but which is absent longitudinal folds. Thus, Lazar not only fails to anticipate the claimed invention, but Lazar also fails to render the present claims obvious, for at least the reason that Lazar fails to teach or suggest every element recited in the claims.

M.P.E.P. § 2143. Applicants therefore respectfully request reconsideration of the rejection.

VI. Rejections under 35 U.S.C. § 103

A. Lazar

Claims 82, 83, and 87 have been rejected under 35 U.S.C. § 103 as allegedly obvious over Lazar. According to the Office, while Lazar does not directly disclose the claimed properties, "it would have been obvious to one of ordinary skill in the art to apply the folding method of Lazar to various sizes and weights of webs" Office Action at 4. Applicants respectfully traverse for at least the reasons discussed above, in

that Lazar fails to teach a paper napkin product containing no longitudinal folds and at least one transverse fold. Since it is not obvious from Lazar to provide a product with no longitudinal folds and at least one transverse fold, application of that fold to another size or weight of product cannot be obvious.

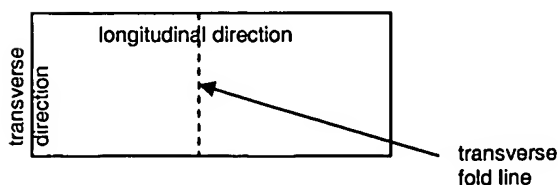
B. Lazar in view of Frick

Claims 85 and 88-90 have been rejected under 35 U.S.C. § 103 as allegedly obvious over Lazar in view of U.S. Patent No. 3,401,928 to Frick ("Frick"). The Office admits that "Lazar does not directly disclose producing three paneled products," yet attempts to rectify this deficiency with Frick: "Frick teaches a method of transversely folding a single ply web twice for the creation of a three paneled product comprising two panels of approximately equal areas." Office Action at 4-5. Applicants respectfully traverse.

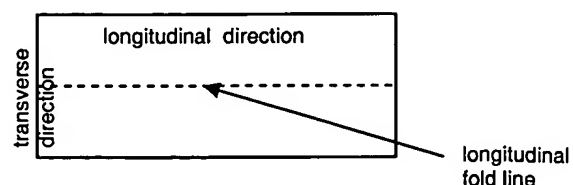
To establish obviousness, the Office must demonstrate, among other things, that the references teach or suggest all of the claim elements. M.P.E.P. § 2143. Yet neither Lazar nor Frick discloses a paper napkin product containing no longitudinal folds and at least one transverse fold.

In this regard, Applicants respectfully assert that the Office has mischaracterized Frick. While Frick does disclose transverse folding, it is important to understand that transverse folding results in a longitudinal fold line and does not result in a transverse fold line, as claimed herein. The diagrams below illustrate:

Longitudinal Folding



Transverse Folding



Frick discloses transverse folding, and thus, as shown above, a paper web that has longitudinal folds. Yet the present claims are directed towards a paper napkin product containing no longitudinal folds. Hence, neither Frick nor Lazar, taken separately or together, renders the present claims obvious, and Applicants respectfully request reconsideration of the rejection.

VII. Conclusion

The Office has failed to provide a single reference which teaches or suggest the claimed napkin product containing no longitudinal folds and at least one transverse fold. Thus, In view of this shortcoming, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 6, 2005

By: Erin C DeCarlo
Erin C. DeCarlo
Reg. No. 51,688